

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT G. ARSENAULT and TAM T. LEMINH

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Appeal No. 2004-0845  
Application No. 09/492,725

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ON BRIEF

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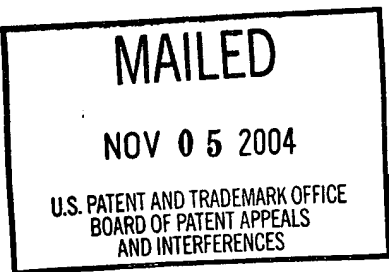
Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 18-47, which are all the claims remaining in the application.

We affirm-in-part.



BACKGROUND

The invention relates to digital video transmission systems and, in particular, to a system and method for transmitting, receiving, and displaying advertisements via a digital video transmission system. Claim 18 is reproduced below.

18. A digital advertisement system for use in receiving, processing and displaying digital advertisement information, the digital advertisement system comprising:

a processor;

a memory communicatively coupled to the processor;

a first software routine stored on the memory and adapted to be executed by the processor to receive advertising objects and image objects linked to the advertising objects from a transmitted data stream;

a second software routine stored on the memory and adapted to be executed by the processor to select a first group of advertising objects from the received advertising objects and image objects based on a local condition; and

a third software routine stored on the memory and adapted to be executed by the processor to sequentially display the first group of advertising objects using ones of the image objects linked to the first group of advertising objects.

The examiner relies on the following reference:

Hite et al. (Hite)

5,774,170

Jun. 30, 1998  
(filed Dec. 13, 1994)

Claims 18-47 stand rejected under 35 U.S.C. § 102 as being anticipated by Hite.

We refer to the Final Rejection (Paper No. 4) and the Examiner's Answer (Paper No. 10) for a statement of the examiner's position and to the Brief (Paper No. 9) and

the Reply Brief (Paper No. 13) for appellants' position with respect to the claims which stand rejected.

### OPINION

Appellants submit (Brief at 7) that the claims stand or fall together. However, appellants' arguments are not consistent with the proposed grouping. We will consider the limitations of the claims discussed by appellants (i.e., the independent claims), with the dependent claims standing or falling with the corresponding independent claims. See 37 CFR § 1.192(c)(7) (1997); 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

Instant claim 41 requires, inter alia, software to generate a plurality of advertisement objects, each of which includes data elements associated with scheduling and display of one of the digital advertisements, generate an identifier object having specified data elements, and link image objects containing image information associated with the digital advertisements to the advertisement objects. The examiner has not pointed out where all the claimed features may be found in Hite, but appears to rely on a finding of inherency; i.e., that the "formats" are "practiced in the television industry and known to those skilled in the art." (Answer at 11.)

If what claim 41 requires is "inherent" in Hite, the examiner could have, and should have, provided an additional reference. When a reference is silent about an

asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Mere allegations of inherency, however, are not sufficient.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)  
(citations omitted).

We thus cannot sustain the rejection of claim 41 and its dependent claims.

Independent claims 18 and 24 require, as appellants note, the use of linkages between advertising objects and image objects. We do not find any satisfactory response to the argument from the examiner. Nor does the statement of the rejection point out where corresponding disclosure may be found in the reference.

In the remarks bridging pages 17 and 18 of the Answer, the examiner contends that linking one object to another is "inherently practiced" in the field of object-oriented programming. The rejection has not established, however, that Hite discloses, expressly or inherently, the linkage as required by claims 18 and 24.

We thus cannot sustain the rejection of independent claim 18 or 24, nor their dependent claims.

We disagree with appellants, however, that independent claim 35 requires any form of linkage as set forth in the other independent claims. The claim recites generating a first ordered list associated with a first advertisement display portion of the user interface. Hite discloses (col. 4, ll. 45-51) that the Commercial Identifier (CID) code may be sequential such that a viewer would see a series of commercials in correct order, thus disclosing a "first ordered list." The "first advertisement display portion," as broadly claimed, does not distinguish over any or all portions of a video screen on which the commercial advertisements are displayed. Claim 35 further recites sequentially displaying advertisements in this display position based on the ordered list, consistent with Hite's disclosure.

Finally, claim 35 recites that the first ordered list contains a prioritized sequence of "advertising objects." A principal point of contention between the examiner and appellants relates to interpretation of the claim terms "advertising objects" and "image objects." Appellants argue that the "objects" must be interpreted as digital data structures with characterizing data elements. The examiner submits (e.g., Answer at 14) that the terms may be interpreted as requiring no more than graphical video images that can be perceived on a video screen. Unlike the other independent claims on appeal, the patentability of claim 35 reduces to consideration of the broadest reasonable interpretation of "advertising objects."

Appellants argue that the "objects" in the claims are defined by the instant specification and must be interpreted accordingly. Appellants refer us, in the briefs, to

portions of the disclosure where the definitions are thought to be set forth. We are mindful, however, that claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

We have studied the instant specification, but find only exemplary embodiments that do not necessarily limit the literal term “advertising objects,” devoid of modifiers that relate to the art of object-oriented programming as the term appears in claim 35. Our findings are, in short, consistent with appellants’ admonitions set out in the paragraph bridging pages 4 and 5 of the Brief. We do not find any special definitions set forth in the disclosure to narrow the term as used in the claim. Cf. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (repeating the principle that where an inventor chooses to be his own lexicographer and gives terms uncommon meanings, he must set out the uncommon definition in the patent disclosure). See also Beachcombers Int’l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) (“As we have repeatedly said, a patentee can be his own lexicographer provided the patentee’s definition, to the extent it differs from the conventional definition, is clearly set forth in the specification.”); Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (there is a “heavy presumption” that claim language has its ordinary meaning).

Appeal No. 2004-0845  
Application No. 09/492,725

Applicants for patent may amend their claims if the language is not limited to the scope intended. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

We therefore sustain the rejection of claim 35 and its dependent claims (36-40), but not the rejection that is applied against the remainder of the claims.

#### CONCLUSION

We affirm the rejection under 35 U.S.C. § 102 over Hite with respect to claims 35-40, but reverse with respect to claims 18-34 and 41-47. The examiner's decision in rejecting claims 18-47 is thus affirmed-in-part.


Appeal No. 2004-0845  
Application No. 09/492,725

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

*Anita Pellman Gross*  
ANITA PELLMAN GROSS  
Administrative Patent Judge

  
HOWARD B. BLANKENSHIP  
Administrative Patent Judge

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AND  
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Appeal No. 2004-0845  
Application No. 09/492,725

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